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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/770,599	01/26/2001	Eric Neil Miller	0370-1-1	6893

7590 02/27/2004

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EXAMINER

NGUYEN, TAN D

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 02/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/770,599	MILLER ET AL	
	Examiner	Art Unit	
	Tan Dean D. Nguyen	3629	

**-- The MAILING DATE of this communication appears on the cover sheet with the response address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 January 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

There is no amendment to the claims filed. This is merely a Response.

### ***Response to Arguments***

1. Applicant's arguments filed 1/27/04 have been fully considered but they are not persuasive.

Applicant's arguments with respect to the rejections of claims 1-2 under 35 U.S.C. 102(b) and 103 are not persuasive because they appear to be applicant's opinions. For this type of "swearing back declaration", applicant must submit an Affidavit or Declaration Under 37 CFR 1.131 or 1.132 (See MPEP 715.10, 716).

### ***Claim Rejections - 35 USC § 112***

2. Claims 1-2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The preambles of both claims 1 and 2 calls for "charitable donation management and reporting" but the limitation of "reporting" is not discussed and shown in the body of the claim.

Applicant's response is noted, however, this is not found to be persuasive because the elements discussed do not show any teaching of "reporting" at all or how "reporting" is related to the elements discussed.

Applicant's response with respect to the term "object" is persuasive and the rejection has been withdrawn.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2 are rejected under 35 U.S.C. 102(b) as being described in a website (www.donate.net) in this country or in public use in this country, more than one year (Dec. 12, 1998 or Jan. 25, 1999) prior to the date of application for patent in the United States (Feb. 1, 2000).

The website above, discloses a method and system for charitable donation management and reporting as shown in claims 1-2 above (see pages 1-10 of the submitted documents by the examiner). The displaying of both the donation and purchase is shown on page 4 as indicated by "Donation" and "Purchase Book". The payment using a credit card with authorization, confirmation, acknowledgement, and delivery address are shown on page 9 with the security protection by Verisign (see page 6). The hyperlink (or link) to the website is shown on page 7. Other minor limitations are inherently included in the operation menu and system of the website above.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 1 are rejected under 35 U.S.C. 103(a) as being unpatentable over ARTICLE 11/1999 alone or further in view of KOREEDA or KOLLING ET AL.

As for claim 2, ARTICLE 11/1999 fairly discloses a method for supporting special project/campaign by the charity's organization and providing charitable donation management and reporting, the method providing a communication link to a charitable organization's Internet website ([www.toysfortots.org](http://www.toysfortots.org)), comprising the steps of: a) a donation step to the charity organization, b) displaying a selected asset (toys) for purchase, c) displaying donation level (50% off the regular retail price) in concert with the selected asset to the donor, d) purchasing the selected asset responsive to the display of the selected donation level, f) displaying selective payment information (credit card), and h) hyperlinking to the charitable organization's website (see abstract). As for the limitation of requesting a donation, this would have been obvious in view of the general teaching of ARTICLE 11/1999 which discloses several suggestions for giving such as "In the spirit of holiday giving", "facilitating program to facilitate the donation .... where consumers can donate...", "will point consumers to the eToys web site where they can make the purchase". Therefore, it would have been obvious to receive a request from the donor to make a donation in response to the request by WingspanBank.com above. As for the display of both the purchase request and donation request in concert, ARTICLE 11/1999 appears to disclose the display of the purchase and donation steps in succession; however, it would have been obvious to disclose the display of the purchase and donation steps in concert to complete the

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transaction of purchasing and donation in one transaction, thus saving time and improving record keeping or report. As for step (e) and (g), these are inherently included in the teaching of ARTICLE 11/1999 to properly deliver the toy to desired recipient and completing the payment step using credit card. Note also that steps (e) – (g) are conventional on online payment system using credit card and would have been obvious to an ordinary skill to apply these steps.

KOREEDA or KOLLING ET AL is cited to teach conventional steps or system for online shopping and payment method and system (see KOREEDA Fig. 2, 3, 8, 9A, 14-17 or KOLLING ET AL (Figs. 11, 12, 14). It would have been obvious to modify ARTICLE 11/1999 to include steps (e)-(g) as taught by KOREEDA or KOLLING ET AL to complete online payment and product delivery accurately, securely and safely.

As for claim 1, these are fairly shown in ARTICLE 11/1999 alone or further in view of KOREEDA or KOLLING ET AL as indicated above since the carrying out of a step would require an equivalent system/structure to support the method steps. Alternatively, the setting up of correspondent structure or element to carry out the donation steps as shown on claim 2 above would have been obvious to a skilled artisan.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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8. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113 or PAIR system at 866-217-9197 (toll-free) or <http://pair-direct.uspto.gov>.

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail [CustomerService3600@uspto.gov](mailto:CustomerService3600@uspto.gov).

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053. My work schedule is normally Monday through Friday from 7:00 am through 4:30 pm.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 872-9306. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

Other possibly helpful telephone numbers are:

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/ 8335
Fee Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Information Help Line	1-800-786-9199

dtn  
February 25, 2004

  
**DEAN T. NGUYEN**  
**PRIMARY EXAMINER**